

REMARKS

The Office Action dated July 1, 2005, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, the Specification and claims 1-3 have been amended. The amendments to the Specification correct minor informalities. The amendments to the claims do not narrow the scope of the claims, but merely clarify features existing in the claims as originally filed.

Claims 1-3 are pending and respectfully submitted for consideration.

The Specification was objected to for minor informalities. The Applicant has amended the Specification responsive to the objection.

Claim 1 was objected to for a minor informality. The Applicant has amended claim 1 responsive to the objection.

Claims 1-3 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Applicant has amended claims 1, 2 and 3 to positively recite the method steps. The Applicant respectfully submits that all claims are in compliance with U.S. patent practice.

Claims 1-3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Tamura (U.S. Patent No. 5, 353,699). The Applicant traverses the rejection and respectfully submits that claims 1-3 recite subject matter that is neither disclosed nor suggested by Tamura. Claims 2 and 3 depend from claim 1.

Tamura is directed to a harness producing apparatus and method which aims to correctly apply a distinctive mark at a given position of a harness, and simplify

construction of a harness producing apparatus. See Abstract. Tamura discloses a cable feeding mechanism for feeding an electrical cable in its longitudinal direction; a marking mechanism disposed on an upper stream along a cable feeding direction of said cable feeding mechanism for applying a distinctive mark on said electrical cable. See column 3, lines 30-37 of Tamura. Tamura further discloses "an electrical cable 50 fed intermittently by the cable feeding mechanism 110 [is] passed in sequence through the straightener 90, marking mechanism 200. . . [c]onsequently, a harness 51 having a distinctive mark 53 on a given area on the outer face and terminals 52 on the opposite ends shown in Fig. 7 is produced successively." See column 4, lines 59-68 of Tamura.

With respect to claim 1, the Applicant respectfully submits that Tamura fails to disclose or suggest the claimed features of the invention. Claim 1, as amended, recites a process for mounting a plurality of parts to a cable comprising mounting the plurality of parts in mounted positions and in mounted attitudes determined respectively for the parts, and marking the cable with information for the mounting for each of the parts before the mounting of the parts.

The Office Action took the position that Tamura discloses "a process for mounting a plurality of parts (52) to a cable or harness (50, 51) comprising: determining a mounting position and attitude respectively for the parts, wherein information (53) for the mounting of each of the parts is marked on the cable before the mounting of the parts (See Figs. 7 and 9)." See paragraph 6 of the Office Action. The Applicant respectfully submits that Tamura fails to disclose or suggest at least the feature of marking the cable with information for the mounting for each of the parts before the mounting of the parts. Tamura does not disclose or suggest that the distinctive marks

53 provide information for mounting the terminals 52 to the harness 51. Tamura discloses that the terminals 52 are pressed-attached on the stripped end of the residual cable 50 by the terminal-pressed-attaching mechanism 160. See column 7, lines 22-27 of Tamura. There is no disclosure or suggestion in Tamura that the distinctive markings 53 provide any information for mounting the terminals 52 to the harness 51, because the terminals are not mounted anywhere near the markings. In contrast, Tamura discloses “a distinctive mark is applied on an outer periphery on each electrical cable in order to easily distinguish a cable kind in each harness.” See column 1, lines 13-15 of Tamura. Therefore, Tamura does not disclose or suggest at least the feature of marking the cable with information for the mounting of each of the parts before the mounting of the parts, as recited in claim 1.

Claim 2 recites marking the cable with a name, the mounted position and the mounted attitude of each of the parts. The Office Action took the position that “Tamura discloses the information including displaying a name, a mounted position and a mounted attitude of each of the parts (see Fig. 10, column 1, lines 13-15).” See paragraph 6 of the Office Action. However, as discussed above, this section of Tamura cited in the Office Action “discloses a distinctive mark is applied on an outer periphery on each electrical cable in order to easily distinguish a cable kind in each harness,” and does not disclose or suggest that the distinctive marks display a mounted position and a mounted attitude of each of the parts. Thus, there is no disclosure or suggestion in Tamura of at least the feature of marking the cable with a name, the mounted position and the mounted attitude of each of the parts, as recited in claim 2.

Claims 1 and 2 were rejected under 35 U.S.C. §102(b) as being anticipated by Yazawa (Japanese Patent Publication No. 06-223639). The Applicant traverses the rejection and respectfully submits that claims 1 and 2 recite subject matter that is neither disclosed nor suggested by Yazawa.

Yazawa discloses a wire marked with information about a mating side. According to the English language Abstract, Yazawa discloses a wire 1 assembled into a device marked with information 2 about the mating side of the device, so that assembling error, or the like, can be prevented.

As noted above, claim 1 recites mounting the plurality of parts in mounted positions and in mounted attitudes determined respectively for the parts. The Office Action took the position that a plurality of parts (10, 11) are mounted to a cable and that information (2) for mounting each of the parts is marked on the cable before the mounting of the parts. See paragraph 7 of the Office Action.

In contrast, the Applicant respectfully submits that there are no markings on the wire 1 with information for the mounting of element 10 in Yazawa. The Japanese term corresponding to the “mating side information” in the English language Abstract of Yazawa is more correctly translated into “assembling point information”. In Fig. 1(b), the Japanese characters indicated by reference numeral 2 (assembling point information) are translated into “TO BE CONNECTED TO No. 1”. That is, the assembling point information merely shows a connecting point of another member to which an end portion of the wire itself should be connected. Specifically, reference numeral 2 indicates instructions for connecting the wire 1, not for the mounting of parts to the wire 1 in Yazawa. Therefore, in contrast to the Office Action’s position, Yazawa

discloses reference numeral 2 providing assembling point information, which is not an indication of where to mount a plurality of parts. Thus, Yazawa fails to disclose or suggest a cable marking with information for the mounting of element 10. Therefore, Yazawa fails to disclose or suggest at least the features of mounting the plurality of parts in mounted positions and in mounted attitudes determined respectively for the parts, as recited in claim 1.

As noted above, claim 2 recites marking the cable with a name, the mounted position and the mounted attitude of each of the parts. The Office Action took the position that Fig. 3 and the information includes displaying a name, mounted position and a mounted attitude of each of the parts. See page 4, lines 8 and 9 of the Office Action. However, as discussed above with respect to claim 1, the Japanese characters indicated by reference numeral 2 are translated as "TO BE CONNECTED TO No. 1". Thus, the Applicant respectfully submit that there is no disclosure or suggestion of at least the features of marking the cable with a name, the mounted position and the mounted attitude of each of the parts, as recited in claim 2.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "Every element of the claimed invention must be arranged as in the claim. . . [t]he identical invention must be shown in as complete detail as is contained in the patent claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989)

(Emphasis added). Accordingly, claims 1 and 2 are not anticipated by Tamura and Yazawa, nor are claims 1 and 2 obvious in view of Tamura and Yazawa.

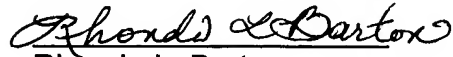
Claims 2 and 3 depend from claim 1. The Applicant respectfully submits that each of these claims incorporates the patentable aspects thereof, and is therefore allowable for at least the same reasons as discussed above. Accordingly, the Applicant respectfully requests withdrawal of the objections and rejections, allowance of claims 1-3, and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper,

may be charged to counsel's Deposit Account No. 01-2300, referencing Attorney Dkt.
No. 107348-00358.

Respectfully submitted,



Rhonda L. Barton
Attorney for Applicant
Registration No. 47,271

Customer No. 004372
ARENT FOX PLLC
1050 Connecticut Avenue, N.W., Suite 400
Washington, D.C. 20036-5339
Tel: (202) 857-6000
Fax: (202) 638-4810

RLB/elz